

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant argument filed 04/09/2008 has been received.
2. Provisional Non-Statutory Double Patenting Rejection: Applicant will consider filing a terminal disclaimer to obviate these rejections when the present application is otherwise in condition for allowance.
3. The amendment of claims 1, 11, and 18 is acknowledged.
4. In view of the amendment to claims 1, 11 and 18, the rejection under 35USC 102 is withdrawn.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Art Unit: 2624

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 and 21 of copending Application No. 10/722631. Claims 1 and 11 are narrower than claim 1 and 15 for instance:

Application 10/722795	Application 10/722631
An input device for scanning a biometric image, comprising	An input device for scanning a biometric image, comprising
a housing	a housing
a scan head <i>movably</i> mounted to the housing <i>wherein the scan head is comprised of at least a light source and a linear array of gradient indexed lenses</i>	a scan head mounted to the housing

a platen moveably mounted to the housing and the scan head for movement relative to the housing and the scan head between a first position and a second position;	a platen moveably mounted to the housing <i>for movement relative to the housing</i> and the scan head between a first position and a second position;
and a biasing device configured to bias the platen toward the first position.	and a biasing device configured to bias the platen <i>into its</i> first position.

Although the conflicting claims are not identical, they are not patentably distinct from each other because omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Examiner Notes***

7. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 7-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuli et al (5,942,761) in view of Angelo et al (US 6,182,892).

As to claim 1, Tuli teaches an input device for scanning a biometric image, comprising: a housing (figure 1-element 1); a scan head movably mounted to the housing wherein the scan head is comprised of at least a light source and linear array of gradient indexed lenses (figure 1-element 7); a platen moveably mounted to the housing and the scan head for movement relative to the housing and the scan head between a first position and a second position (figure 1-element 5); and a biasing device configured to bias the platen toward the first position (figure 1, element 9) a start of scan switch located such that the start of scan switch is activated when the platen moves in a downward translation from the first position and an end scan switch located such that the end of scan switch is activated when the platen is at the second position (The movable transparent platen has an initial position and a terminal position, such that the method of scanning begins with the finger pressed against the platen in its initial position and pushed until the platen reaches its terminal position, whereby the solid state elements read multiple lines of the finger as it moves towards the terminal position, column 2, lines 30-37) While Tuli meets a

Art Unit: 2624

number of the limitations of the claimed invention, as pointed out more fully above, Tuli fails to specifically teach that the linear array are of gradient indexed lenses .

Specifically, Angelo et al. teaches the imprint platen 110 and the image port 114 are connected by a gradient index optical path 302. The path is optically transparent such that the imprint of a finger can be illuminated and read by the live-scan device 104 (figure 3). It would have been obvious to one of ordinary skill in the art to use a gradient index lens in Tuli in order to create a greater offset between the imprint on the card and the live-scan device without the need for adjusting the live scan optics for the angle of the image. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention by applicant.

As to claim 2, Tuli teaches the device of claim 1, further comprising an encoder target (figure 4-emenet 13, the glass or transparent platen 5 is shown to have a patterned strip 13 which determines the rate at which information is sent to the device's microprocessor).

As to claim 3, Tuli teaches the device of claim 1, wherein the biasing device is an extension spring (The spring system 9 is always extended to apply a force to pull the platen towards the rest position, and also applies a force to keep the platen in the rest position when not in use, column 6, lines 1-9).

As to claim 4, Tuli teaches the device of claim 1, wherein the biometric image is a fingerprint (figure 1- element 17 from finger 8, column 5, lines 36-60).

As to claim 7, Tuli teaches the device of claim 2, wherein the scan head is adaptive to capture a scan line as the platen is moved (column 6, lines 39-67).

Art Unit: 2624

As to claim 8, Tuli teaches the device of claim 2, wherein the scan head is configured to scan a pattern on the encoder target and to capture a scan line of the biometric image and the corresponding pattern on the encoder target (column 5, lines 55-57; column 6, lines 39-46).

As to claim 9, Tuli teaches the device of claim 8, wherein the pattern on the encoder target is used to combine a series of scan lines to form an image representative of the biometric image (column 6, lines 47-67).

As to claim 10, Tuli teaches the device of claim 9, wherein the biasing device (figure 1, element 9) is a coiled spring (spring 9, figures 1-2).

As to claim 11, Tuli teaches an input device for scanning a biometric image, comprising: a housing having an angled way (figure 1, element 1); a platen moveably mounted to the housing for movement between a first position and a second position (figure 1, element 7), the platen being adaptive to receive the biometric image (column 6, lines 51-55); a scan head, comprised of at least a light source and a linear array of gradient indexed lenses (see Angelo et al, figure 3), moveably mounted to the angled way, wherein movement of the platen causes the scan head to translate along the angled way; and an encoder target (column 6, lines 39-50).

As to claim 12, Tuli teaches the device of claim 11, further comprising a spring, the spring biasing the scan head assembly against the platen so as to bias the platen toward the first position (note that scanning begins with the finger pressed against the platen in its initial position and pushed until the platen reaches its terminal position and the static friction of the fingertip against the glass or transparent platen is greater than the kinetic friction of the platen against its housing elements, figures 1 and 2)

As to claim 13, Tuli teaches the device of claim 11, wherein the scan head is configured to scan a pattern on the encoder target and to capture a scan line of the biometric image and the corresponding pattern on the encoder target (column 6, lines 39-46).

As to claim 14, Tuli teaches the device of claim 11, wherein a pattern on the encoder target (figure 4- element 13, column 6, lines 48-50) is used to combine a series of scan lines to form an image representative of the biometric image (column 5, lines 55-57).

As to claim 15, Tuli teaches the device of claim 11, wherein a force applied to the platen is transferred to the scan head so as to direct the scan head to traverse the platen (FIG. 16. A mechanical means is employed to traverse the internal housing across the platen, as it simultaneously moves downward equidistant from the platen, by the applied force of the finger).

As to claim 16, Tuli teaches the device of claim 13, wherein the pattern is used to combine a series of scan lines to form an image representative of the biometric image (column 6, lines 47-67).

As to claim 17, Tuli teaches the device of claim 12, further comprising a spring (figure 2, element 9), the spring biasing the scan head assembly against the platen so as to bias the platen toward the first position (note that the spring system 9 is always extended to apply a force to pull the platen towards the rest position, and also applies a force to keep the platen in the rest position when not in use, column 6, lines 1-21)

The limitation of claim 18 has been addressed above.

As to claim 19, Tuli teaches the device of claim 18, wherein a pattern on the encoder target includes a pattern the pattern being used in operation to combine a series of scan lines to form an image representative of the biometric image (column 6, lines 47-67).

As to claim 20, Tuli teaches the device of claim 18, further comprising a biasing device, the biasing device configured to resist movement of the scan head from a first position to a second position (note upon removing the finger from the glass or transparent platen in the position of FIG. 2, or at any intermediate location between starting and terminating positions, the platen returns to the rest position of FIG. 1 due to the force applied by the spring system 9, column 5, line 10-40).

As to claim 21, Tuli teaches the device of claim 18, wherein the encoder target comprises a repeating pattern (figure 4, element 13).

As to claim 22, Tuli teaches the device of claim 18, wherein the platen provides a substantially flat contact surface for the biometric image (figure 3, element 12-column 16, lines 33-36).

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuli (U.S. Patent No. 5,942,761) in view of Scott et al. (U.S. Patent No. 6,178,255). Hereinafter referred to as Tuli and Scott respectively.

As to claims 5 and 6, While Tuli meets a number of the limitations of the claimed invention, as pointed out more fully above, Tuli also teaches that the housing is configured to provide a support surface (Fig. 3 element 12 -Col. 6 lines 33 - 36) and the platen moves parallel to the support surface (Fig. 1-initial state- vs. Fig.2 -final state-); However, Tuli fails to teach that the encoder target comprises a non-repeating pattern. Pertaining to the same field of endeavor, Scott teaches a similar fingerprint scanner where the position of the platen is determined by viewing a bar code (called a "caliper") along side the desired finger print (Scott Fig. 10 - element 90 and Fig. 11) [Note that the caliper is a non-repeating 12-bit binary code pattern, See Scott Col. 6 lines 11 - 21]. Furthermore, Scott teaches that the use of such a caliper allows for individual segments of a fingerprint, which have been randomly recorded and stored, to be accurately and coherently reassembled (Scott Col. 2 lines 46 - 51). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace Tuli's repeating pattern with a non-repeating pattern as taught by Scott to relax the requirements of sequentially recording and storing the fingerprint scan lines while still accurately reproducing the image.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY BITAR whose telephone number is (571)270-1041. The examiner can normally be reached on Mon-Fri (7:30a.m. to 5:00pm).

Art Unit: 2624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew W. Johns/  
Primary Examiner, Art Unit 2624

Nancy Bitar

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